

DETAILED ACTION

This action is in response to papers filed January 18, 2008.

Claims 1, 4-6, 22, 22, 29 and 31 have been amended.

Claims 3 and 13-4 are cancelled.

Claims 1-2, 4-12 and 15-33 are pending.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 29 and 31-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1, 29 and 31 the claims recite the limitation of an evaluator "module". System claims are to be directed to the structure, and as disclosed the applicants "evaluator" can be a human being doing the evaluation. Therefore, as claiming a human being the claims as currently written fail to fall within the statutory requirements.

As to claim 31 the claims is directed to computer programming software per se. Software is not with in the statutory categories. The programming fails to be embodied on a tangible medium that is read by computer. Applicant is advised corrective claim language that embodies the programming tangibly on a medium to be read by a computer would be adequate to meet the statutory requirements.

Claim Rejections - 35 USC § 103

1. Claims 1-2, 4-12 and 15-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20020032659 A1 Waters; System and Method for Obtaining and Developing Technology for Market in view of US Patent 6298327 Hunter et al; Expert Support System for Authoring Invention Disclosures.
- 2.
3. As to claims 1, 11, 22, 29 and 31-33 Waters teaches:
 - Receiving information regarding inventive ideas (Pg. 3 ¶ 6).
 - Evaluating invention potential (Pg. 3 ¶ 19).
 - Providing database of information to potential costumers of inventions (Pg. 3 ¶ 19).
4. However, Waters fails to teach “classifying” the inventions into class/subclass and “technical categories. Hunter teaches classifying the inventions according to the USPTO classification schedule (C. 12 l. 24-27). It would have been obvious to one skilled in the art at the time of invention to combine Hunter with Waters as by classifying the invention this will assist in prior art identification helping establish any legal or commercial viability.
5. Furthermore, Waters and Hunter fail to teach interaction between an innovator and a consumer as one being anonymous. However, Powell teaches users wishing to keep their identity anonymous. (C. 29 l. 23-28). It would have been obvious to one skilled in the art at the time of invention to combine Powell with Waters and Hunter as

originators with possible solutions can not disclose who has a particular need, which information could signal trouble to the investment community or signal a weakness to a competitor.(Powell C. 29 l.32-35)

6. As to claims 2, 12 and 23 Waters teaches the evaluation as prior art searches (Pg. 3 ¶ 19).

7. As to claims 4, 15 and 24 Waters being possibilities for funding(Pg. 5 ¶31).

8. As to claims 8, 21 and 28 Waters teaches a information disclosure process and disclosure review. However, Waters fail to teach translating information into the desired languages Hunter teaches a translating the abstract(a brief description of the invention) (C. 15 l. 23-23. It would have been obvious to one of skill in the art at the time of invention to combine this limitation with Waters so as to not limit the type or nationality of costumers who may be interested in funding an invention. Furthermore it would have been obvious as these are guidelines as set for by the PCT Patent application according to WIPO 1994(Hunter C. 15 l. 20).

9. As to claims 9 and 17 Waters teaches indicating current patent art pertaining to invention (Pg. 4 ¶24).

10. As to claims 10 and 18 Waters teaches controlling access to the customers (Pg. 5 ¶30).

11. As to claims 7, 20 and 27 Waters teaches paying inventor royalties (Pg. 5 ¶30).

12. As to claim 16 Waters teaches refining invention after initial evaluation (Pg. 4 ¶21).

13. As to claim 25 Waters teaches experts (humans) reviewing inventions (Pg. 3 ¶ 19). The examiner notes that this limitation, although taught by the prior art, is considered intended use. By having a human perform functions of the process is merely how applicant intends to use the process.
14. As to claim 26 Waters teaches the computer processing controlling the interactions between users (Pg. 3 ¶ 18).
15. As to claim 30 Waters teaches a company running the databases. (Pg. 4 ¶ 26).

Response to Arguments

16. Applicant's arguments with respect to claims 1-2, 4-12 and 15-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3689